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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Serge Haumont

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DITTHAVONG MORI & STEINER, P.C.

918 Prince St.

Alexandria, VA 22314

EXAMINER

FOUD, HICHAM B

ART UNIT

PAPER NUMBER

2419

MAIL DATE

DELIVERY MODE

08/18/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/520,430	Applicant(s) HAUMONT, SERGE	
	Examiner HICHAM B. FOUD	Art Unit 2419	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/01/2009 has been entered.

Response to Amendment

2. The amendment filed on 07-01-2009 has been entered and considered.
Claims 20-62 are pending in this application.
Claims 1-19 have been canceled.
Claims 20-62 remain rejected as discussed below.

Claim Objections

3. Claim 62 is objected to because of the following informalities:
In claim 62 line 9, the term "a network node" seems to refer back to the same term in line 8. If so, it is suggested that the second term be replaced by --the network node--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

Art Unit: 2419

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 20-62 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 20, 36, 53 and 62, recites that “said encapsulated application level message is transparent to devices of said access network”. However, in the specification [0035] lines 17-20 of the publication recites that there is only one device which is the SGSN and not devices as claimed. Moreover, the last limitation recites that “said encapsulated application level message is sent after a PDP context is accepted”. However, the above limitation does not always happen since it is only one condition from a plurality of conditions that said encapsulated application level message includes (see specification [0038] lines 6-18 of the publication and claim 40). Thus, Examiner concludes that the claimed features indicated above are new matter and without further teachings, one skilled in the art does not know how to make and use the claimed invention without undue experimentation.

Claims 39 and 46 recite that “interpreting....to send the encapsulated application level message”. However, in the specification [0038] lines 21-23 of the publication discloses the sending of the extracted contents not the encapsulated application level message as claimed. Moreover, the last limitation recites that the sending is in

Art Unit: 2419

accordance with one or more of the interpreted address, a PDP context and an access point name configuration. However, in case of "more", the sending for example can be in accordance with the interpreted address and an access point name configuration.

This is untrue based on the specification [0038] lines 1-6 of the publication which states that the sending can be based on either IP address or logical name. Thus, Examiner concludes that the claimed features indicated above are new matter and without further teachings, one skilled in the art does not know how to make and use the claimed invention without undue experimentation.

Claims 21-35, 37-38, 40-45, 47-52 and 54-61 are rejected because of their dependency on the rejected claim.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 20-62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 20, 36, 53 and 62, recites that "said encapsulated application level message is transparent to devices of said access network". However, in the specification [0035] lines 17-20 of the publication recites that there is only one device which is the SGSN and not devices as claimed. Moreover, the last limitation recites that "said encapsulated application level message is sent after a PDP context is accepted". However, the above limitation does not always happen since it is only one condition from a plurality of conditions that said encapsulated application level message includes

Art Unit: 2419

(see specification [0038] lines 6-18 of the publication and claim 40). Therefore, it is not known the metes and the bounds of the claimed invention.

Claims 39 and 46 recite that “interpreting....to send the encapsulated application level message”. However, in the specification [0038] lines 21-23 of the publication discloses the sending of the extracted contents not the encapsulated application level message as claimed. Moreover, the last limitation recites that the sending is in accordance with one **or more** of the interpreted address, a PDP context and an access point name configuration. However, in case of “more”, the sending for example can be in accordance with the interpreted address and an access point name configuration. This is untrue based on the specification [0038] lines 1-6 of the publication which states that the sending can be based on either IP address **or** logical name. Therefore, it is not known the metes and the bounds of the claimed invention.

Claims 21-35, 37-38, 40-45, 47-52 and 54-61 are rejected because of their dependency on the rejected claim.

The claims are rejected as best understood.

Claim Rejections - 35 USC § 102

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. Claims 20-22, 24, 26, 28, 36, 37, 53, 54, and 58-59 are rejected under 35 U.S.C. 102(a) as being anticipated by Greis et al (WO 01/86974).

For claim 20, Greis discloses a method comprising: receiving an application level message (see page 11 lines 1-2; QoS is application specific) from a sender application process (see Figure 1 element 11; data bearer service manager) to an access network

Art Unit: 2419

signaling process (see Figure 1 element 11; data bearer service manager and see page 10 line 32 to page 11 line 5; this may also be accomplished by the data bearer service manager); encapsulating said application level message in a signaling message of an access network (see page 11 lines 1-3 and lines 19-24; QoS is embedded in the message); initiating transmission of said application level message to a network node by transmitting said signaling message (see Figure 3 step 1; PDP context request), wherein said application level message is transparent to devices of said access network transmitting said signaling message (see page 11 lines 31 to page 12 line 5; the messages are transported between the nodes), said application level message comprises an indication of conditions to deliver the application message (see page 12 lines 7-9; QoS), and said application level message is sent after a PDP context is accepted (see Figure 3 step 4 which is done after step 1; PDP activation).

For claims 21 and 54, Greis discloses a method wherein said sender process is performed in a mobile terminal coupled to said access network (see Figure 3).

For claim 22 and 37 Greis discloses a method wherein said sender process is performed in an application server configured to provide a corresponding application (see page 15 lines 5-7, the mobile can be a laptop computer).

For claims 24 and 56, Greis discloses a method wherein said indication comprises an indication of whether to deliver said signaling message when the QoS changes (see page 12 lines 7-9; QoS).

For claims 26 and 58, Greis discloses a method wherein said encapsulated application level message is included in a PDP context (see page 11 lines 19-24).

For claim 28 and 59, Greis further discloses that RSVP may be embedded in PDP context (see page 4 lines 22-28).

Claims 36 and 53 are rejected for the same reasons as claim 20.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 23, 25, 27, 38-43, 46-50, 55, 57 and 62 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Greis in view of Dorenbosch et al (US 2003/0217174).

For claims 23 and 55, Greis discloses all the subject matter with the exception of wherein said indication comprises an address being one of a logical name, an IP address and a port number. However, Dorenbosch discloses a method wherein the signaling message included the mobile station's IP address (see Figure 2 step 205; MS_IP_add). Thus, it would have been obvious to the one skill in the art at the time of the invention to include an indication of the IP address for the purpose of identifying the station and communication.

For claim 25 and 57, Greis discloses all the subject matter with the exception of wherein the method of implementing VOIP. However, Dorenbosch discloses a method that uses the SIP for establishing VOIP method (see [0011] lines 4-9). Thus, it would have been obvious to the one skill in the art at the time of the invention to add a SIP for the purpose of implementing VOIP that is cheaper than the landline connection.

For claim 27 and 38, Greis discloses all the subject matter with the exception of wherein the application server is one of the group comprising a proxy call state control function, a push proxy server and an IMS. However, an official notice is taken in that a server could be either proxy call state control function or push proxy server which functions are well known and expected. Thus, it would have been obvious to the one skill in the art at the time of the invention to use a proxy call state control function for example instead of the server for the purpose of controlling and maintaining the calls.

For claim 39 and 46, Greis discloses a method, comprising: receiving an encapsulated application level message (see Figure 3 step 1 and page 11 line 31 to page 12 line 5; When received the QOS “encapsulated”, the SGSN must extract the QOS for negotiation); extracting content from the encapsulated application level message (see Figure 3 step 1 and page 11 line 31 to page 12 line 5; When received the QOS “encapsulated”, the SGSN must extract the QOS for negotiation); interpreting, from the extracted content of the encapsulated application level message, conditions to send the encapsulated application level message (see Figure 3 step 1 and page 11 line 31 to page 12 line 5; When received the QOS “encapsulated”, the SGSN must extract the QOS for negotiation) and initiate sending of the extracted content to an application server (see Figure 1: elements 1 and 3 and/or page 10 lines 16-26 and/or page 11 lines 1-24; the negotiation requires receiving the QOS). Greis further discloses that the added information may also comprise various other information (see page 7 lines 21-23). Greis discloses all the subject matter with the exception of explicitly disclosing the address and initiate the sending in accordance with one or more of the interpreted

Art Unit: 2419

address, a packet data protocol context and an access point name configuration.

However, Dorenbosch discloses the address (see Figure 2 step 205; MS_IP_add) and initiate the sending in accordance with one or more of the interpreted address, a packet data protocol context and an access point name configuration (see [0015] lines 24-28).

Thus, it would have been obvious to the one skill in the art at the time of the invention to include an indication of the IP address for the purpose of identification for routing and communication.

For claim 40 and 47, Greis further a method, wherein the conditions to send the encapsulated application level message comprise when a packet data protocol context is accepted or when a packet data protocol context is accepted with a desired quality of service (see Figure 3 step 4 which is done after step 1; PDP activation).

For claim 41 and 48, Greis in view of Dorenbosch discloses all the subject matter with the exception of explicitly disclosing when the address is indicated as a logical name, the logical name is resolved from the access point name configuration or by querying a directory name service system. However, an official notice is taken in that when the address is indicated as a logical name, the logical name is resolved from the access point name configuration or by querying a directory name service system. Thus, it would have been obvious to the one skill in the art at the time of the invention to resolve a logical name from the access point name configuration or by querying a directory name service system for the purpose of translation and communication.

For claim 42 and 49, Greis further a method, wherein the encapsulated application level message is included in an activation request within a packet data protocol context signaling (see page 11 lines 19-24).

For claim 43 and 50, Greis further a method, wherein a session initiation protocol signaling, a resource reservation protocol signaling, or a point to point protocol signaling is embedded into said packet data protocol context signaling (see page 4 lines 22-28).

Claim 62 is rejected for same reasons as the combination of claims 20 and 39.

Allowable Subject Matter

8. Claims 29-35, 44-45, 51-52 and 60-61 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Argument

9. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

10. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., reduce the number of round trips needed to establish a connection by piggybacking application level signaling inside of GPRS signaling (see pages 23-25 of the Remarks) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Moreover, the claimed limitations of independent claims are still broad and if a claim is

Art Unit: 2419

subject to more than one interpretation, at least one of which would render the claim unpatentable over the prior art, the examiner should reject the claim over the prior art based on the interpretation of the claim that renders the prior art applicable. *Ex parte Ionescu*, 222 USPQ 537 (Bd. Pat. App. & Inter. 1984). *In re Wilson*, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). Therefore, claims are given their broadest reasonable interpretation. The Federal Circuit's *en banc* decision in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) because although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

11. Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner. In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Art Unit: 2419

When responding to this office action, applicants are advised to clearly point out the patentable novelty which they think the claims present in view of the state of the art disclosed by the references cited or the objections made. Applicants must also show how the amendments avoid such references or objections. See 37C.F.R 1.111(c). In addition, applicants are advised to provide the examiner with the line numbers and pages numbers in the application and/or references cited to assist examiner in locating the appropriate paragraphs.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HICHAM B. FOUD whose telephone number is (571)270-1463. The examiner can normally be reached on Monday - Friday 10-6 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pankaj, Kumar can be reached on 571-272-3011. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hicham B Foud/

Examiner, Art Unit 2419

08/13/2009

/Pankaj Kumar/

Supervisory Patent Examiner, Art Unit 2419